



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,962	10/07/2003	Shlomo Touboul	1259-0022	6073
11788 7590 10/25/2011 Stolowitz Ford Cowger LLP / ptomail 621 SW Morrison Street Suite 600 Portland, OR 97205				
EXAMINER ANWARI, MACEEH				
ART UNIT 2451		PAPER NUMBER		
NOTIFICATION DATE 10/25/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail@stofoco.com

Office Action Summary

Application No.

10/680,962

Applicant(s)

TOUBOUL ET AL.

Examiner

MACEEH ANWARI

Art Unit

2451

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 38-52 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 38-52 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. This action is in response to communications filed on 07/19/2011. **Claim(s) 38-39, 42-43 and 48** have been amended. No other claims have been amended, added, or canceled. Accordingly, **claim(s) 38- 57** are pending.

Response to Arguments

2. Applicant's arguments filed 07/19/2011 have been fully considered but they are not persuasive. In substance applicant argues: A) that there is no motivation for combining Shaikh with Ng; B) that neither Ng nor Shaikh discloses "embedding a control mark within an electronic document created by a document word processor, such that when a body of the document is changed by the document word processor after the control mark is embedded in the document, the control mark remains embedded in the document without having to re-embed the control mark in the document and wherein the control mark cannot be changed or removed by means of the document word processor".

3. In response to A), the examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837, F.2n 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner specifically provided the rationale that a more secure and reliable system can be realized by allowing the filing of documents

electronically with the same certainty of doing so in person. Shaikh specifically teaches assuring authenticity of the electronic stamp by storing the electronic document in a form that limits access and/or modification (abstract). Therefore, it is respectfully maintained that the combination of Ng and Shaikh is still valid.

4. In response to B), the examiner respectfully disagrees. It appears that the applicant's are arguing against the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As was specifically stated in the non-final office action mailed 06/09/2011, Ng was only used to disclose "monitoring transmitted network packets, for detection of network packets containing the electronic document, based on the control mark, in order to block access to the electronic document from unauthorized recipients" and "that the body of the document may be changed by the document word processor." Shaikh teaches at col. 1 line 31-col. 2 line 7 that the electronic copy of the document is filed with a permanent electronic stamp. The permanent stamp here has been simply interpreted as an unchanging/unchangeable control mark. Therefore, Ng-Shaikh still reads on this limitation.

5. Applicant's representative is strongly urged to contact the examiner and set up an interview in order to help overcome these inconsistencies and to help forward prosecution.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 38- 57** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ng (U.S. Pat. #: 6, 640,301 B1)** and further in view of **Shaikh (U.S. Pat. #: 7, 035, 830 B1)**.

8. Regarding **claim 38 Ng** discloses: a method for controlling access to and tracking the routing of an electronic document, comprising:

embedding a control mark (**Fig. 1 & 3A; digital signature, encryption, PGP**), within an electronic document created by the document word processor, (**Fig. 4 & 6; MSG ID'S, CKSUM KEYS, PAD all within email message body**);
and

detecting transmitted network packets, containing the electronic document, based on the control mark, in order to block access to the electronic document from unauthorized recipients (**Fig. 7; extracting MSG ID, and Message verification**).

Ng discloses the invention as disclosed above.

Ng furthermore discloses such that when a body of the document is changed by the document word processor after the control mark is embedded in the document, the control mark remains embedded in the document without having to re-embed the control mark in the document(**Ng at least in Fig. 8A-9C,**

11-12; compose email module for outgoing emails and various e-mail with respective replies).

However, **Ng** does not appear to explicitly disclose wherein the control mark cannot be changed or removed by means of the document word processor and blocking access to the electronic document from unauthorized recipients.

In the same field of endeavor **Shaikh** discloses wherein the control mark cannot be changed or removed by means of the document word processor and blocking access to the electronic document from unauthorized recipients (**Shaikh: Fig. 2-5 and Abstract & col. 1 line 31- col. 2 line 7; electronic copy of document filed with permanent electronic stamp, and limiting access to the to the server/document to at least one authorized user**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine or modify **Shaikh's** teachings of remote filing and recordation of documents with those of **Ng's** to form a more secure and reliable messaging system (i.e. by allowing the filing of documents electronically as if—or with the same certainty—of doing so in person col. 2 lines 25-35).

9. Regarding **claim 39 Ng-Shaikh** further discloses: further comprising logging an audit record of the transmission, when a network packet containing the electronic document is detected by said detecting, wherein the audit record stores information identifying a distribution route of the electronic document (**Fig. 10; Lookup tables and indexing IDs**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

10. Regarding **claim 40 Ng-Shaikh** further discloses: wherein said logging includes logging a date and time of the transmission in the audit record (**Fig. 8A-B; date and time fields**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

11. Regarding **claim 41 Ng-Shaikh** further discloses: wherein said logging includes logging a destination of the transmission in the audit record (**Fig. 8A-B; “To” and “From” fields**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

12. Regarding **claim 42 Ng-Shaikh** further discloses: wherein said detecting monitors network packets transmitted internally within an organization network (**Fig. 4 & 6-7; outgoing and incoming e-mail messages being monitored**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng with Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

13. Regarding **claim 43 Ng-Shaikh** further discloses: wherein said detecting monitors network packets transmitted from within an organization network to outside of the organization network (**Fig. 4 & 6-7; outgoing e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

14. Regarding **claim 44 Ng-Shaikh** further discloses: wherein said detecting monitors network packets transmitted to an organization network from outside of the organization network (**Fig. 4 & 6-7; in coming e-mail messages via the Internet**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

15. Regarding **claim 45 Ng-Shaikh** further discloses: wherein the network packets are transmitted in response to an FTP download (**Col. 15 lines 9-17; either E-mail or FTP can be used to send messages**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

16. Regarding **claim 46 Ng-Shaikh** further discloses: wherein the network packets are transmitted in response to an HTTP download (**Col. 2 lines 53- 62 and col. 15 lines 9-17; HTTP**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

17. Regarding **claim 47 Ng-Shaikh** further discloses: wherein the network packets are transmitted in response to an Instant Messenger download (**Col. 15 lines 9-17; other file transfer methods**).

One of ordinary skill in the art at the time of the given invention would have been motivated to combine the teachings of **Ng** with **Shaikh**, in the instant claim, for the same reasoning and rationale as in **claim 38**.

Regarding **claims 48-57**, they list substantially the same elements found in **claims 38-47**, but in system form rather than method form, therefore **claims 48-57** are rejected using the same reasons and rationale as applied to **claims 38-47**.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

/John Follansbee/

Application/Control Number: 10/680,962

Page 10

Art Unit: 2451

Supervisory Patent Examiner, Art Unit 2451